

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance or into better condition for appeal.

This invention provides for, *inter alia*, herbicidal composition which may be used against harmful plants in tolerant or resistant crops of sugar beets. The inventive composition and methods employ a herbicidal combination comprising at least two different herbicides.

Pursuant to 37 C.F.R. §1.136(a) and §1.17(a), a two-month extension of the period for reply, i.e., to up to and including October 7, 2003, is requested. A check for \$420.00 is enclosed. The Commissioner is authorized to charge any additional fee for consideration of this paper or credit any overpayment in such fees, to Deposit Account No. 50-0320.

Claims 21-47 are pending. Claims 21, 30, 34 and 36 are amended without prejudice. Applicants amended the disclaimer in claim 21 to correct a typographical error in which the compound clodinafop was inadvertently deleted. Thus, no new matter has been added. As this does not change the intended scope of the claims, it does not affect the application of the doctrine of equivalents. Further, this Amendment cancels, without prejudice, compounds A3 from the claims in order to advance prosecution. Applicants reserve the right to file a divisional application to any of the cancelled embodiments.

Claims 30-35 stand rejected under the judicially created doctrine of double patenting for allegedly being unpatentable over claims 33, 34, and 44 of copending Application No 09/762,673, and claim 20 of Application No 09/371,612.

Submission of a terminal disclaimer is respectfully deferred until an indication of allowable subject matter is made, and whether such is necessary in view of the claims allowed.

Claims 21, 23-31, 33, 35, 45 and 47 were rejected under 35 U.S.C. §§102(a) and (e) for allegedly being anticipated by Flint et al., U.S. Patent No 6, 239, 072 ("Flint"). Specifically, the Examiner alleges that Flint teaches the combination of glyphosate with several of the claimed secondary herbicides for use in controlling weeds and volunteer crop plants in transgenic glyphosate resistant crops, including sugar beets. Applicants respectfully disagree. Further, Flint is not a competent reference against the application for controlling weeds and volunteer crop plants in sugar beets.

Flint has a U.S. filing date of March 9, 1999 and claims priority to provisional application 60/077,241 ("provisional application"), which in turn was filed on March 9, 1998. The present application was filed from PCT/EP99/05799, filed on August 10, 1999 and claims priority to DE 198 36 673.6, filed August 13, 1998. Thus, Flint arguably is only prior art against the present application based on the subject matter that is disclosed in the provisional application.

Against this background, a close examination of the provisional application will reveal that there is no disclosure for the control of glyphosate-susceptible weeds and glyphosate-tolerant volunteer individuals of the first species in a crop of glyphosate-tolerant second species where the crop is sugar beets. The provisional application purportedly discloses only corn, cotton sorghum, peanut, rice and soybean (cf. page 11, lines 4 to 20 of the provisional application). The passage in Flint referred to by the Examiner in the rejection was added after the provisional application was filed.

In view of the foregoing, it is urged that Flint does not anticipate the instant invention, since the earliest date that Flint disclosed sugar beets is March 6, 1999, a date which is after the German priority date of the present application. Accordingly, reconsideration and withdrawal of these rejections are requested.

Further, it is noted that the Notification of Acceptance, dated August 13, 1998, indicated that the Patent Office received a translation of the international application and a copy of the priority document. Should the Examiner still require a certified English translation of the priority document, it is requested that the Examiner makes this request and one will be provided.

Claims 21-47 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Flint in view of WO 98/09525 to Novartis ("Novartis"). Applicants disagree. As the rejection does not establish a *prima facie* case of obviousness, reconsideration of this rejection is requested.

In order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying the reference's teaching. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q. 2d 1529, 1531 (Fed. Cir. 1988).

At the outset, it is urged that Flint is not prior art against the present invention since there is no disclosure for controlling weeds when sugar beets are the herbicide resistant crop. While the rejection alleges that one of ordinary skill in the art would be motivated to use prosulfuron, primisulfuron, dicamba, pyridate, dimethenamide, metolachlor, fluometuron, propaquizafop, atrazine, clodinafop, norfluazon, ametryn, terbutylazine, simazine, prometryn, and four additional

agents (NOA-402989 and compounds I-III) in combination with phosphorous containing herbicides for weed control in herbicide resistant crops, the provisional application does not disclose an herbicidal combination for treating sugar beets. Hence, Flint is not competent prior art.

Moreover, even if it were a competent reference, the combination of Flint with Novartis still does not render the present invention unpatentable. Contrary to the allegations in the Final Office Action, there is not a single Flint combination of glyphosate and other herbicides cited in the Final Office Action which corresponds to the instantly claimed herbicide compositions for weed control. Further, Flint does not disclose, enable or suggest unexpected synergism of the combined herbicides for weed control. On the contrary, in column 4, lines 48, Flint discloses the possibility of **antagonism**:

One possible difficulty that may be posed to mixtures in embodiments of the present invention is antagonism between the glyphosate herbicide and the non-glyphosate herbicide, or between either herbicide and a surfactant or other inert ingredient. Antagonism is defined as a negative interaction between the components of a mixture of herbicides, which results in inferior control of target weeds relative to what would be expected from considering the activities of the component herbicides individually.

Hence, if anything, Flint teaches away from the present invention. Moreover, as Flint lacks any teaching, suggestions or enabling disclosure of herbicides used for weed control in sugar beet crops, the reference is obviously silent to unobvious synergistic effects of herbicide action on sugar beet crops described in the instant invention.

Novartis does not remedy these inherent deficiencies. Although Novartis relates to the control of weeds in useful plant cultivations, such as the cultivations of maize, soya, cotton, rape, beet and sugar cane, it does not provide the requisite suggestion or motivation that would lead one of ordinary skill in the art to combine its teachings with that of Flint in order to practice the instantly claimed invention.

If one compares the disclosures of Flint and Novartis with respect to combinations of glyphosate and other herbicides, one will see that there is no overlap in the definition of glyphosate combination partners of the instant claims and Novartis (see Table attached). An inspection of the Table will also show that there is also no overlap in the definition of glyphosate combination partners of the instant claims and Flint.

Although Flint may, arguably disclose the use of fenoxaprop, the racemate, the disclosure is generic to fenoxaprop-P and does not motivate one of ordinary skill in the art to practice the instantly claimed invention since the provisional application indicates that fenoxaprop functions merely as a secondary herbicide against herbicidally resistant soybean and cotton. There is no mention of fenoxaprop-P in the examples or tables and there is no disclosure of the use of a herbicidal combination containing fenoxaprop-P. Moreover, Flint only mentions fenoxaprop as a mixing partner for fluazifop-P-butyl under trade name FUSIONS® in the tables 7 and 8.

Although Novartis lists the crop ‘sugar beet’ beside several other crops (page 4, fourth paragraph) it is lacking any teaching of further details, e.g. biological examples without any reference about the tested crops and the test results obtained. So, Novartis neither is reporting a better synergistic effect for weed control in sugar beet crop nor is it contemplating any such effect for the combination defined in claim 21.

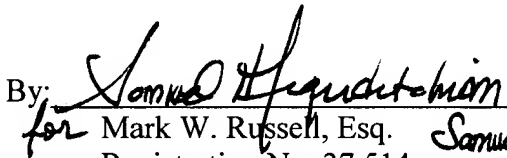
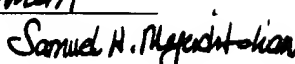
Thus, as Flint and Novartis fail, both alone and in combination, to teach, suggest or motivate a skilled artisan to practice the instantly claimed invention, the Section 103 rejection must fail. Further, “obvious to try” is not the standard upon which an obviousness rejection should be based. As “obvious to try” would be the only basis by which the obviousness rejection could stand, it is respectfully submitted that the Section 103 rejection must fail for this reason as well.

Moreover, even if one were to argue that the combination of Flint and Norvartis is proper, a point which Applicants do not concede, it is urged that the combination still does not render compositions of group (A) herbicides and fenoxaprop-P obvious. The data presented in Table 5 of the specification indicates that a remarkable and unexpected synergistic effect is observed when this composition is applied to weeds that typically occur in sugar beets that are resistant to group (A) herbicides. Flint is totally silent with respect to synergy with the herbicidal combinations disclosed generically or specifically therein. In view of the discussion in Flint about antagonism, one of ordinary skill in the art would understand that Flint assumes additive effects at most, and that this occurs only in glyphosate-tolerant corn and soybeans. Hence, from the disclosure in Flint or Novartis, the results in Table 5 are clearly unexpected.

Consequently, reconsideration and withdrawal of the Section 102 and 103 rejections are respectfully requested.

Favorable consideration of claims 21-47 is earnestly solicited. If, however, there is still an outstanding issue, the Examiner is invited to contact the undersigned for its prompt attention.

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**Table: Combination partners for glyphosate according to Flint .
Novartis and the present invention**

'Flint et al.' (Provisional Application No. 60/077,241)	'Novartis' (WO 98/09525)	Present Invention	
		Claim 30 (Composition)	Claim 21 (Method of Use)
		ethofumesate	ethofumesate
		desmedipham	desmedipham
		phenmedipham	phenmedipham
		quinmerac	quinmerac
quizalofop			quizalofop (2)
			quizalofop-P
fenoxaprop (1)			fenoxaprop (2)
		fenoxaprop-P (1)	fenoxaprop-P
fluazifop			fluazifop (2)
			fluazifop-P
		haloxyfop	haloxyfop
		haloxyfop-P	haloxyfop-P
		cyhalofop	cyhalofop
	clodinafop		
	propaquizafop		
sethoxydim			sethoxydim (2)
		cycloxydim	cycloxydim
clethodim			clethodim (2)
imazamox			
imazethapyr			
imazaquin			
	prosulfuron		
	primisulfuron		
	dicamba		
	pyridate		
	dimethenamide		
	metolachlor		
	fluometuron		
	atrazine		
	norflurazone		
	ametryn		
	terbutylazine		
	simazine		
	prometryn		
	NOA-402989 and 3 other compounds		